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In re Application of
Scott Burton et al
Serial No.: 10/728,446
Filed: December 5, 2003
Attorney Docket No.: 59427US0002

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: PETITION DECISION
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This is in response to the petition under 37 CFR 1.144, filed November 1, 2007, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on December 5, 2003, and contained claims 1-44. In a first Office action, mailed April 16, 2007, the examiner required restriction between the inventions claimed, as follows:

Group I – claims 1-14, 25 and 36-37, drawn to a method of coating a silver compound on a substrate;

Group II – claims 15-24, 26 and 38, drawn to a method of coating a silver compound on a substrate;

Group III – claims 27-35 and 39, drawn to a method of coating a silver compound on a substrate; and

Group IV – claims 40-44, drawn to a article comprising a porous substrate impregnated with a silver compound

An election of species was also required if any of Groups I-III were elected.

The examiner stated that Groups I-III were unrelated as having different designs. The examiner noted that Group II required silver oxide and ammonium carbonate to effect the silver coating which the other Groups did not require and that Group III required only silver oxide. Groups I-III were also stated to be distinct from Group IV, drawn to an article.

Applicants replied on May 8, 2007, electing Group I with traverse, and a species, as required. Applicants requested reconsideration of the species requirement and the restriction between Groups I-III, arguing that Group I is generic to Groups II and III and there is no additional search burden imposed on the Office by this relationship.

The examiner mailed a new Office action to applicants on July 20, 2007, acknowledging the election of Group I and the species, and the traversal of the requirements. The examiner withdrew the election of species requirement, but maintained the restriction requirement on the basis that Group II requires silver oxide and ammonium carbonate not required by Group I and Group III required ammonium carbonate not required by Group I. The examiner continued to maintain the search for the various components would be an undue burden. The examiner made the requirement Final. The examiner also held the failure to argue the restriction with respect to Group IV as an election without traverse. Claims 1-44 were then provisionally rejected for obvious double patenting over SN 10/917,002. Claim 25 was rejected under 35 U.S.C. 112, first paragraph, as lacking written description. Claims 14 and 25 were rejected under 35 U.S.C. 112, second paragraph, as indefinite. Claims 1-2, 5, 9-14, 25 and 36 were rejected under 35 U.S.C. 102(b) as anticipated by GB 769,799. Claims 3-4, 7-8 and 37 were rejected under 35 U.S.C. 103(a) as unpatentable over GB 769,799 in view of WO 02/43743. Claim 6 was rejected under 35 U.S.C. 103(a) as unpatentable over GB 769,799 in view of US 4,592,920.

Applicants replied on October 22, 2007, amending claims 1, 15 and 25, and responding to all of the rejections of record.

This petition was filed on November 1, 2007, traversing the restriction requirement as being in error.

DISCUSSION

Applicants' petition is directed to the restriction between Groups I-III, the method of making claims and that Group I is generic to Groups II and III and no restriction should be required as there is no undue burden to search all three sets of claims.

As set forth, original Claim 1 requires combining a sparingly soluble silver compound with an ammonium compound in an aqueous solution and coating the solution on a substrate and drying. Various dependent claims define specific silver compounds (claim 5, 6) including silver oxide and ammonium compounds (claim 7, 8) including ammonium carbonate. Claim 15 requires combining silver oxide with ammonium carbonate in an aqueous solution and coating the solution on a substrate and drying. Claim 27 requires combining silver oxide with an ammonium containing compound and an oxidizing agent in an aqueous solution and coating the solution on a substrate and drying.

Although the examiner based the restriction requirement on claims 1, 15 and 27, it is clear from a review of the claims that claims dependent on claim 1, such as claims 5-8, recite all of the limitations of claim 15 and all of the limitations of claim 27 except the oxidizing agent which is set forth in claim 12. Based on this and the requirement of the examiner to search all of the limitations of the claims of elected Group I, no requirement for restriction is proper. Further, it is noted that each of Groups I-III is classified in the same class and subclass defeating the examiner's argument of undue search burden.

It is noted that applicants' petition does not argue the restriction between Groups I-III and IV.

DECISION

The petition is **GRANTED**. Claims 1-39 will be examined together. Claims 40-44 remain withdrawn.

The application will be forwarded to the examiner for consideration of applicants' reply filed October 22, 2007, and further action not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

A handwritten signature in black ink, appearing to read "Bruce M. Kisliuk", with a long horizontal flourish extending to the right.

Bruce M. Kisliuk
Director, Technology Center 1600